



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,172	11/14/2001	Nicholas F. Baida	GK-BAIDA-102/500764.20002	6892

7590 06/04/2003

Gerald H. Kiel  
Reed Smith LLP  
375 Park Avenue  
New York, NY 10152

EXAMINER

HOOOLAHAN, AMANDA J

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/992,172	BAIDA, NICHOLAS F.	
	Examiner	Art Unit	
	Amanda J Hoolahan	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 April 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

1. An issue of public use of on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:

Applicant states in the Affadavit under 37 CFR 1.131 filed on April 7, 2003 that a working prototype was reduced to practice prior to December 18, 2001. However, Applicant further states that the working prototype was reduced to practice prior to his meeting with Stanley Tools and The Perfect Tape Measuring Company. Exhibits A and B indicate that these meetings took place before August 14, 2000 and August 29, 2000 which are the dates of the exhibits. Thus, the actual date of the invention appears to be before August 14, 2000, which is more than one year from the filing date of this application.

Applicant is reminded that failure to fully respond to this requirement for information will result in holding of abandonment.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6, and 12 are finally rejected under 35 U.S.C. 102(b) as being unpatentable by USPN 5,430,952 to Betts.

Numeral A has been added to Figure 4 by the examiner in reference to a certain component of the device disclosed by Betts. See copy attached at the end of this action.

Betts discloses a shell casing for enclosing a case of a tape measure comprising a first concave shell (10) with malleable interior sections; a second concave shell (A) with malleable interior sections; adjustable connection means for connecting said first concave shell to said second concave shell thereby enclosing the case of the tape measure (column 2, lines 18-19); a blade (118) connected to at least one of said concave shells; a retractable blade molded into at least one of said concave shells wherein said retractable blade is molded flush within said concave shell (column 3, lines 17-21); a lead pencil (121) connected to at least one of said concave shells; a tape measure (11) in a case; a retractable cutting blade located inside said case and arranged to make cuts corresponding to measurement increments arranged on tape measure; normal use of this device comprises the method step of making precise measured cuts on objects comprising the step of measuring a distance using a combination tool comprising a tape measure in a case and cutting the object at said measured distance by extending a retractable blade located inside said case wherein said blade is arranged to make cuts corresponding to measurement increments arranged on said tape measure.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 7-10, and 14-15 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Betts in view of USPN 4,760,648 to Doak et al. [hereinafter Doak].

Numeral A has been added to Figure 1 by the examiner in reference to a certain component of the device disclosed by Doak. See copy attached at the end of this action.

Betts discloses the device as described above in paragraph 3.

Betts does not disclose a retractable pencil molded into at least one of the concave shells wherein said retractable pencil is molded flush within concave shell; a retractable pencil molded inside said case in a flush manner and arranged to make pencil marks corresponding to measurement increments arranged on said tape measure, said tape measure including a nail hole at its exposed end.

With respect to claims 5, 7, 9, and 10: Doak discloses a tape measure tool comprising a retractable pencil (52) molded into at least one of the concave shells (12) wherein said retractable pencil is molded flush within concave shell; a retractable pencil molded inside said case in a flush manner and arranged to make pencil marks corresponding to measurement increments arranged on said tape measure (14). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the pencil, as taught by Betts, with the retractable pencil, as taught by Doak, in order for the pencil to be in a more convenient location for easier utilization by the user.

With respect to claims 7 and 8: Doak discloses a tape measure including a nail hole at its exposed end (A). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add a nail hole, as taught by Doak, to the end of the

tape measure, as taught by Betts, in order for the device to have an area where an object can hold the tape measure down without damaging the tape.

With respect to claim 14: Normal use of the device disclosed by Betts and Doak as described above comprise the method steps of making a measurement mark in pencil by extending a retractable pencil lead corresponding to said measurement marks on said tape measure; including a nail hole in said tape measure at an exposed end; inserting a nail through said nail hole into the object; and rotating said case about the nail in arc to make a circular measured cut in the object.

6. Claims 11 and 13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Betts and Doak as applied to claim 7 above, and further in view of USPN 6,178,655 to Potter et al. [hereinafter Potter].

Betts and Doak disclose the device as described above in paragraph 5.

Betts and Doak do not disclose the device comprising a clear indicator window located proximate to said tape measure said indicator window including an index line with said measurement increments.

With respect to claim 11: Potter discloses a measuring device comprising a clear indicator window located proximate to said tape measure said indicator window including an index line with said measurement increments (30). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the indicator window, as taught by Potter, to the device, as taught by Betts and Doak, in order for the user to be able to have a better focus on the measurement increments.

With respect to claim 13: Normal use of the device disclosed by Betts, Doak, and Potter as described above comprise the method step of positioning the clear window above said measurement increments to view and line up said measurement increments with an index line which corresponds to measurement increments on said tape measure.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda J Hoolahan whose telephone number is (703) 308-0139. The examiner can normally be reached on Monday through Friday 8:00 am to 4:30 pm.

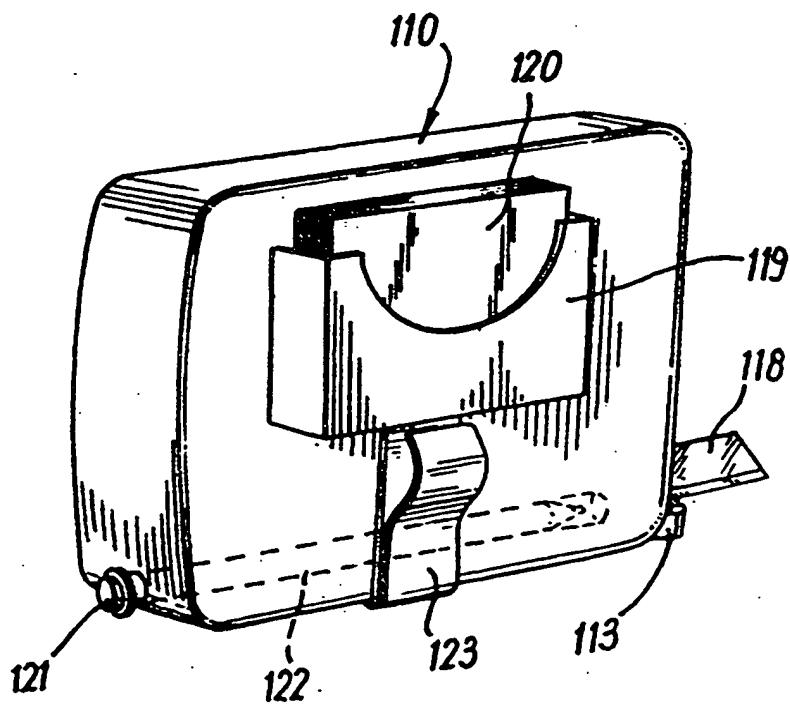
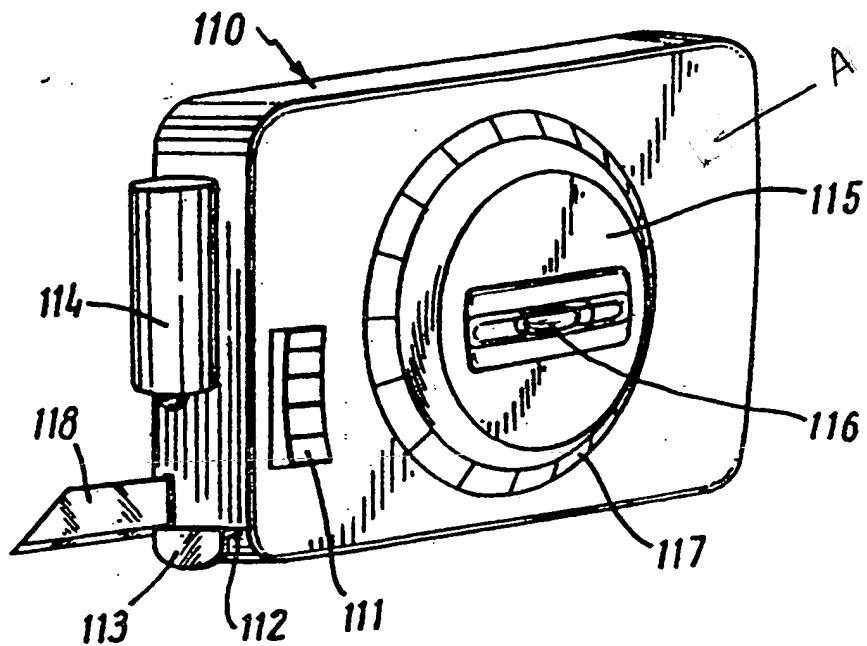
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.



ajh  
May 29, 2003

Diego Gutierrez  
Supervisory Patent Examiner  
Technology Center 2800



# United States Patent [19]

Doak et al.

[11] Patent Number: 4,760,648  
[45] Date of Patent: Aug. 2, 1988

## [54] MARKING DEVICE

[76] Inventors: Sid W. Doak, 1301 Country Club Dr., McCook, Nebr. 69001; Shawn P. Suiter, 2209 Jones St., Omaha, Nebr. 68102

[21] Appl. No.: 920,767

[22] Filed: Oct. 20, 1986

[51] Int. CL<sup>4</sup> ..... G01B 3/10

[52] U.S. Cl. ..... 33/668; 33/138

[58] Field of Search ..... 33/189, 138, 139, 140, 33/27.03, 666, 668

## [56] References Cited

### U.S. PATENT DOCUMENTS

2,807,886	10/1957	Aciego	33/668
3,262,211	7/1966	Beckett	33/189
3,336,678	8/1967	Chamberlain et al.	33/189
3,479,742	11/1969	Starkenberg	33/138
3,731,389	5/1973	King	33/138
3,802,083	4/1974	Freed	33/189
4,015,337	4/1977	Taylor	33/189
4,296,554	10/1981	Hammerstrom	33/189

Primary Examiner—William A. Cuchlinski, Jr.

Assistant Examiner—Patrick R. Scanlon

Attorney, Agent, or Firm—Zarley, McKee, Thomte, Voorhees & Sease

## [57] ABSTRACT

A marking device is described which is adapted to be mounted on one side of a tape measure which is comprised of a tape housing having a measuring tape coiled therein for extension therefrom through a tape issuing opening. The marking device comprises a support which is secured to one side of the tape measure housing and which extends forwardly therefrom. An elongated upstanding tubular housing is positioned on the forward end of the support with the lower end of a tubular housing being positioned laterally of the tape issuing opening. A marking member is selectively vertically mounted in the tubular housing which is adapted to be moved downwardly into marking contact with the article being measured.

2 Claims, 2 Drawing Sheets

